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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/310,073	05/10/1999	GARY R. ACKARET	10980623-1	8322

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EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 09/29/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/310,073

Applicant(s)

ACKARET, GARY R.

Examiner

CESAR B PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the response filed on 6/27/2003.

This action is made Non-Final.

2. In the amendment, claims 1-20 are pending in the case. Claims 1, 11, and 18 are independent claims.

3. The rejections of claims 1-6, 10-18, and 20 under 35 U.S.C. 103(a) as being unpatentable over Laursen et al, hereinafter Laursen (Pat.# 6,065,120, 5/16/00, filed 12/2/97, as disclosed in the action mailed on 3/13/02), in view of in view of HP Jetsend Technology Making Device-To-Device Communication Simple, hereinafter Jetsend, <http://web.archive.org/web/19980124223300/www.jetsend.com/Backgrnder.html> (p.1-6, 1/24/98), further in view of view of Wright Jr. hereinafter Wright (Pat. # 5,704,029, 12/30/97) have been withdrawn as necessitated by the amendment.

4. The rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Jetsend, further in view of Wright, and further in view of Paltenghe et al, hereinafter Paltenghe (Pat. # 6,421,729 B1, 7/16/02, filed on 4/14/99) has been withdrawn as necessitated by the amendment.

5. The rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Jetsend, further in view of Wright, and further in view of Covert et al, hereinafter Covert

Art Unit: 2178

(Pat. # 6,334,117 B1, 12/25/01, filed on 11/17/98) has been withdrawn as necessitated by the amendment.

6. The rejections of claims 8, and 19 under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Jetsend, further in view of Wright, further in view of Covert, as applied to claim 7 above, and further in view of Laor (Pat. # 6,041,309, 3/21/00, filed on 12/23/98) have been withdrawn as necessitated by the amendment.

Drawings

7. The drawings filed on 5/10/99 have been approved by the draftsman.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6, 10-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen et al, hereinafter Laursen (Pat.# 6,065,120, 5/16/00, filed 12/2/97, as disclosed in the action mailed on 3/13/02), in view of in view of HP Jetsend Technology Making Device-To-Device Communication Simple, hereinafter Jetsend,

<http://web.archive.org/web/19980124223300/www.jetsend.com/Backgrnder.html> (p.1-6,

Art Unit: 2178

1/24/98), further in view of view of Wu et al. hereinafter Wu (Pat. # 6,243,711, 6/5/2001, filed on 3/6/1998).

Regarding independent claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52, and fig.6-10). The forms are transmitted using an Internet protocol, such as HTTP.

Moreover, Laursen fails to explicitly disclose *a web server having forms printing solution*. Jetsend teaches using a computer or device for sending documents, pictures, etc, to a printer over the Internet with a jetsend--surface-interaction protocol capable printer (p.1, lines 12-29, and p.2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, and Jetsend, because Jetsend teaches above the intelligent negotiation of information, from devices, without user intervention, thus enabling seamless transmission across computer networks.

Furthermore, Laursen fails to explicitly disclose *supporting version controlled forms generation, a request initiating client machine comprising a personal digital assistant*. Wu teaches the creating, displaying(rendering), transferring, of a form(s), which are controlled by a form version—"VitaScript"-- in a PDA (col.15, lines 10-col.16, line 30). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, and Wu, because Laursen teaches above the display of web pages in small-sized, mobile devices, and pda is both mobile, and small in size, and Wu teaches the quick transmission of compact form data to various clients on a network (col.3, lines 1-67), thereby providing the advantage of quickly transmitting the forms across the network.

Regarding claim 2, which depends on claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52, and fig.6-10). Laursen fails to explicitly disclose *an administrative tool set*. Wu teaches administrative options for creating, displaying(rendering), transferring, etc., of a form(s), which are controlled by a form version—"VitaScript"-- in a PDA (col.15,lines 10-col.16, line 30). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, and Wu, because this would permit production of forms for display, and quick processing, and use on PDA or small-sized devices as taught by Wu (col.3, lines 1-67).

Claims 3, 5 are directed towards a computer system for implementing the apparatus found in claims 2, and 1 respectively, and are therefore similarly rejected.

Regarding claim 4, which depends on claim 1, Laursen discloses a browser capable of the accessing, displaying (rendering) of HTML forms, containing JAVA components (col. 14, lines 40-67).

Regarding claim 6, which depends on claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52, and fig.6-10). Laursen fails to explicitly disclose *a jetsend capable hard copy output device*. Jetsend teaches the printing of a document using jetsend

Art Unit: 2178

protocol, and assigning an address to a receiving device (p.1, lines 12-29, and p.2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, and Jetsend, because Jetsend teaches above the intelligent negotiation of information without user intervention, thus enabling seamless transmission across computer networks.

Claim 10 is directed towards a computer system for implementing the apparatus found in claim 6, and is therefore similarly rejected.

Claims 11-17 are directed towards a computer program product on a computer-readable medium for storing the apparatus found in claims 1-2, 1, 1, 6, 6, and 1 respectively and therefore are similarly rejected.

Claim 18 is directed towards a method for implementing the apparatus found in claim 1, and is similarly rejected.

Claim 20 is directed towards a method for implementing the apparatus found in claim 6, and is similarly rejected.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Jetsend, further in view of Wu, and further in view of Paltenghe et al, hereinafter Paltenghe (Pat. # 6,421,729 B1, 7/16/02, filed on 4/14/99).

Regarding claim 9, which depends on claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52, and fig.6-10). Laursen fails to explicitly disclose *a cookie set used to inform the web server where to send a user identified form*. Paltenghe teaches the use of cookies to inform server about documents desired by users (c.2,L.35-c.3,L.50). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, Jetsend, Wu, and Paltenghe, because this would provide users with a more personalized browsing experience, and allow the user to access information desired without having to specify the type of information desired every single time a website is accessed as taught by Palteng above.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Jetsend, further in view of Wu, and further in view of Covert et al, hereinafter Covert (Pat. # 6,334,117 B1, 12/25/01, filed on 11/17/98).

Regarding claim 7, which depends on claim 1, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52, and fig.6-10). Laursen fails to explicitly disclose *a Java vending machine operative to pull a user selected Jetsend job*. Covert teaches the obtaining, and controlling of a print job by a Java applet (col.14,lines 12-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of

Art Unit: 2178

Laursen, Jetsend, Wu, and Covert, because Covert teaches above a form displaying method for conveniently displaying one question or statement at a time on a PDA.

12. Claims 8, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen, in view of Jetsend, further in view of Wu, further in view of Covert, as applied to claim 7 above, and further in view of Laor (Pat. # 6,041,309, 3/21/00, filed on 12/23/98).

Regarding claim 8, which depends on claim 7, Laursen discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HDML microbrowser (col. 15, lines 1-52, and fig.6-10). Laursen fails to explicitly disclose *store a cookie on the web browser of the client machine....detailing a user selected form to be printed and a network address for the output device selected to generate the form*. Laor teaches the storage of a cookie in a client's computer for customizing user's document requests (col.1,lines 27-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Laursen, Covert and Laor, because Laor teaches above the customization of user's requests to align with user's preferences, i.e. device printing the documents.

Claim 19 is directed towards a method for implementing the apparatus found in claim 8, and therefore is similarly rejected.

Response to Arguments

13. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. Concerning Applicant's remarks regarding claim 1, that Wright teaches away from the claimed invention (p.7,L.23-26), the Applicant is directed towards the new grounds of rejection outlined above in view of the newly found prior art reference.

The same reasoning stated above applies to claims 11, and 18.

14. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (p.9, L.6-8), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Art Unit: 2178

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry, **except formal After Final communications**)

Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label “PROPOSED” or “DRAFT”).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).



CESAR B PAULA

Patent Examiner

Art Unit 2178

9/22/03